

### **Remarks**

Claims 1-5 and 7-9 were pending in the above-identified application when last examined. Claims 1-5 and 7-9 are presented for reconsideration and allowance.

### **Claim Rejection under 35 U.S.C. § 102**

Examiner rejected claims 1-2, 4, and 7-9 as being anticipated by Gilliland et al. (US 6,416,238). Applicants respectfully traverse this rejection.

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates, Inc. V. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

The Examiner further states:

In Figure 1, Gilliland discloses an optical assembly comprising a package (10) including an optoelectronic component; an alignment feature (20) mounted to a surface of the package; and a sleeve (30) defining only one bore (32) with an inner surface having a constant inner diameter for receiving and contacting outer surfaces of the alignment feature (20) and a ferrule of a fiber optic connector when the alignment feature and the ferrule are inserted into the bore at opposite ends of the bore so they can be aligned relative to each other.

(See Office Action, page 3)

In the present case, not every feature of claims 1 and 2 are represented in the *Gilliland* reference. Applicants respectfully submit that *Gilliland* does not disclose an alignment feature mounted to a surface of the package and a sleeve receiving the alignment feature and a ferule of a fiber optic connector. Can 30 includes an aperture 32 for receiving a transparent 20. (See *Gilliland*, Col. 4, lines 60-66). Transparent element 20 provides a window in the otherwise opaque can 30 so that an optical diode 80 mounted on the substrate 30 can emit light from the package 10. Transparent element 20 and can 30 are part of package 10 and they cannot be an alignment feature mounted to package 10 and a sleeve receiving the alignment feature.

Due to the shortcomings of the *Gilliland* reference described in the foregoing, Applicants respectfully assert that *Gilliland* does not anticipate Applicant's claims 1 and 2. Therefore, Applicants respectfully request that the rejection of claims 1 and 2 be withdrawn.

Dependent claims 4, 8, and 9 further define patentably distinct independent claim 1. Therefore, dependent claims 4, 8, and 9 are also believed to be allowable. For at least the above reason, Applicants request reconsideration and withdrawal of the rejection of Claims 4, 8, and 9 under 35 U.S.C. § 102.

Dependent claim 7 further defines patentably distinct independent claim 2. Therefore, dependent claim 7 is also believed to be allowable. For at least the above reason, Applicants request reconsideration and withdrawal of the rejection of under 35 U.S.C. § 102.

### Claim Rejection under 35 U.S.C. § 103

Examiner rejected claim 3 under 35 U.S.C. 103(a) as being unpatentable over Gilliland in view of Yonemura et al. (US 6,540,412 B2). Applicants respectfully traverses this rejection.

Appellants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness because, among other reasons, there is no suggestion or motivation to combine the reference teachings as proposed by the Examiner. In the rejection, the Examiner asserts that all of the elements of applicants' claims can be found in the prior art references. This, however, is **not** the proper test for obviousness.

"It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."

*Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

The Examiner has provided no basis for a teaching or suggestion in the prior art for combining elements as proposed in the rejection. The Examiner's argument regarding obviousness is as follows:

It would have been obvious to one of ordinary skill in the art to *recognize the alignment feature (20) taught by Gilliland would be modifiable with a similar size having a bore that would allow a light emitted by the package to pass through.*

(Office action, page 4)

The single sentence italicized above represents the Examiner's only explanation regarding a teaching or suggestion to combine. This sentence, however, is simply an *unsupported statement* made by the Examiner. In order to establish a *prima facie* case, a teaching or suggestion to combine must be found *in the prior art*. See, e.g., *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, *supra*. Such an unsupported statement, however, cannot constitute the evidence required to establish existence of a motivation or suggestion to combine:

Whether the Board relies on an express or an implicit showing [of a motivation, suggestion or teaching to modify the teachings of a reference], it must provide particular findings related thereto.... Broad conclusory statements standing alone are not "evidence".

*In re Kotzab*, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (citing *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999))

Accordingly, the Examiner's statement does not constitute a showing of a teaching or suggestion to combine. At the very least, an Examiner must prove that some motivation or suggestion to combine can be found in knowledge generally

available to one of ordinary skill in the art. In the present case, however, the Examiner provides no evidence that the requisite knowledge is generally available but, instead, attempts to rely on his own personal opinion. Such personal opinion does not represent an adequate substitute for evidence.

In short, it appears that the Examiner's proposed combination of Gilliland et al. and Yonemura et al. is based solely on hindsight derived from appellants' specification. The use of hindsight in this manner is clearly prohibited by the relevant case law:

Obviousness can not be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). As discussed in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the combination.

*In re Dance*, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998)

Obviousness may not be established using hindsight. See *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1551, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

For at least the above reasons, Applicants request reconsideration and withdrawal of the rejection of claim 3 under 35 U.S.C. § 103(a).

Examiner rejected Claim 5 under 35 U.S.C. 103(a) as being unpatentable over Gilliland in view of Irie et al. (US 6,354,747 B1). Applicants respectfully traverses this rejection.

Appellants respectfully assert that the Examiner has failed to establish a *prima facie* case of obviousness because, among other reasons, there is no suggestion or motivation to combine the reference teachings as proposed by the Examiner.

The Examiner has provided no basis for a teaching or suggestion in the prior art for combining elements as proposed in the rejection. The Examiner's argument regarding obviousness is as follows:

It would have been obvious to one of ordinary skill in the art to *recognize the alignment feature (20) taught by Gilliland would be modifiable with a solid partial spherical lens that would allow a light emitted by the package to pass through.*

(Office action, page 5)

The single sentence italicized above represents the Examiner's only explanation regarding a teaching or suggestion to combine. This sentence, however, is simply an *unsupported statement* made by the Examiner.

For at least the above reasons, Applicants request reconsideration and withdrawal of the rejection of claim 5 under 35 U.S.C. § 103(a).

### Conclusion

Applicants respectfully submit that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby requested.

Respectfully submitted,

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/John Pessetto/

John R. Pessetto, Reg. No. 48,369  
KLAAS, LAW, O'MEARA & MALKIN, P.C.  
P.O. Box 1920  
Denver, Colorado 80201-1920  
Tel. (303) 298-9888  
Fax (303) 297-2266